

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte STEN BERNTSEN

---

Appeal No. 1996-2012  
Application 08/146,025<sup>1</sup>

---

ON BRIEF

---

Before CAROFF, HANLON and WALTZ, Administrative Patent Judges.  
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of  
claims 7-15. Subsequent to the final rejection, appellant  
canceled claims 7 and 10 while adding new claims 16-17.  
Accordingly, the claims before us on appeal are claims 8-9 and

---

<sup>1</sup> Application for patent filed November 08, 1993.

11-17.

The claims relate to a process for producing a butter-like food fat spreadable at a refrigeration temperature from 4° to 5°C. Claim 16 is illustrative of the claimed process and reads as follows:

16. A process for producing a butter-like food fat spreadable at a refrigeration temperature from 4° to 5°C, comprising:

passing butter obtained from milk through a kneader;

adding a first portion of an oleaginous material consisting essentially of an oil to the butter to form a first mixture;

passing the first mixture through a first mixing means;

adding a remaining portion of the oleaginous material and water to the first mixture to form a second mixture;

passing the second mixture through a second mixing means;

recovering the butter-like food fat; and

recovering buttermilk obtained as a by-product from production of the butter.

All of the claims on appeal stand rejected for obviousness under 35 U.S.C. § 103 over the following single

Appeal No. 1996-2012  
Application No. 08/146,025

prior art reference<sup>2</sup>:

Antenore et al. (Antenore)                      2130232                      May 31,  
1984  
(published UK Patent Application)

Based upon the record before us<sup>3</sup>, we agree with appellant that the examiner has failed to establish a prima facie case of obviousness. Accordingly, we will not sustain the examiner's rejection.

As we see it, the critical deficiency in the examiner's reasoning lies in a failure to provide any factual basis for her conclusion that "the butterfat homogenization" of Antenore "is seen to knead the butterfat". The examiner has failed to provide any factual basis, nor are we aware of any, for concluding that there is an art-recognized equivalence or association between inverting cream in an homogenizer to form "liquid butter", as in Antenore, and passing butter through a

---

<sup>2</sup>The examiner has indicated (Paper No. 18) that a second rejection under 35 U.S.C. § 103 based upon another reference (Decio) has been withdrawn.

<sup>3</sup>Our decision is based on consideration of the opposing arguments on appeal expressed in appellant's Supplemental Brief (Paper No. 21) and the Examiner's Answer (Paper No. 22) responsive thereto.

kneader as required by the instant claims. In other words, the examiner has not established any art-recognized equivalence between the homogenization step of Antenore and the kneading operation of appellant's claimed process. Of interest in this regard is the fact that, according to appellant's specification (page 2, lines 12-17), the material passed through the kneader in appellant's process is "conventional butter" rather than inverted cream (liquid butter); conventional butter apparently being more amenable to kneading than the "liquid" butter of Antenore. Simply put, we find no suggestion or motivation in the prior art to pass a liquid product (the inverted cream of Antenore) through a kneader.

In a similar vein, the examiner has also failed to provide any factual basis or convincing rationale to support either her conclusion that "to use inverted cream versus butter is seen to be an obvious substitution", or her conclusion that the claimed stepwise addition of vegetable oil, rather than a one step addition as in Antenore, "is seen to be an obvious matter of choice with regard to the particular extent of mixing that is desired and with regard to

Appeal No. 1996-2012  
Application No. 08/146,025

the particular amount of emulsifying that is needed".

Upon the return of this application to the jurisdiction of the examiner, the examiner should reply to the attachment filed Mar. 18, 1996, with Paper No. 25. There is nothing of record to indicate that this attachment titled "Citation of References under 37 CFR § 1.56", has been considered by the examiner.

Appeal No. 1996-2012  
Application No. 08/146,025

For the foregoing reasons, the decision of the examiner  
is reversed.

REVERSED

	)	
MARC L. CAROFF	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ADRIENE LEPIANE HANLON	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

MLC:hh

Appeal No. 1996-2012  
Application No. 08/146,025

Appeal No. 1996-2012  
Application No. 08/146,025

LOWE, PRICE, LEBLANC & BECKER  
99 CANAL CENTER PLAZA, SUITE 300  
ALEXANDRIA, VA 22314